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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,696	01/19/2000	Glenn Petkovsek	USA-P-99-011	3459

7590 12/31/2002  
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EXAMINER	
HENDERSON, MARK T	
ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/487,696

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9-16 is/are allowed.
- 6) ☐ Claim(s) 1-8 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The amendment in Paper No. 10 has been entered.

Claims 1 and 9 have been amended for further examination. Claims 17-20 have been canceled. Claim 21 has been added for examination.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Petkovsek (5,918,802).

Main discloses in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forms a transparent compartment to be adhered to a mailpiece (Col. 2, lines 52-59) having an opening (214) wherein the form is capable of entering); a mail form (100, Col. 2, lines 60-67 and Col. 3, lines 1-3) that is removably attached to the backing sheet and further wherein the mailing sheet is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20).

However, Main does not disclose a mailing form comprised of an adhesive mailing label and a non-adhesive receipt card, wherein the receipt card is removable attached to the backing sheet and is detachably connected to the mailing label.

Petkovsek discloses in Fig. 4 and 5, a mailing form (16) comprised of a removable adhesive mailing label (34, Col. 6, lines 32-40) and a non-adhesive card (18), wherein the card is

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removable attached to the backing sheet (14) and is detachably connected (52) to the mailing label (34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main's mailing assembly to include a mailing form having a label and card as taught by Petkovsek for the purpose of providing an assembly for forming a mailpiece requiring special services without additional adhesives or fixatives for attaching to the mailpiece.

3. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Petkovsek and further in view of Coats et al (5,624,069).

Main as modified by Petkovsek discloses a mailing assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Main does not disclose a third auxiliary label on the backing sheet.

Coats et al discloses in Fig. 3, a mailing assembly comprising a backing sheet (11) forming an envelope (A and B) formed via the adhesive layer and adhered to a mailing form (37), and a third layer (Col. 5, lines 50-56) being an identification label disposed on the surface (25) of the backing sheet (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main's and Petkovsek's mailing assembly to include a third

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layer disposed on the backing layer comprising an auxiliary label as taught by Coats et al for the purpose of providing an identification mechanism for the mailing assembly.

4. Claim 21 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Coats et al (5,624,069).

Main discloses in Fig. 1 and 2, a mailing assembly comprising all the elements as claimed in Claim 1, and as set forth above.

However, Main does not disclose: wherein the backing sheet forms an envelope having a compartment, and wherein the mailing form is sub-divided into a plurality of printed sub-parts.

Coats et al discloses in Fig. 3, a mailing assembly comprising a backing sheet (11) forming an envelope (A and B) formed via the adhesive layer and adhered to a mailing form (37) having printed sub-parts.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mains's mailing assembly and replace the compartment with an envelope forming a compartment as taught by Coats et al for the purpose of providing a more secured compartment structure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia on the sub-parts such as variably printed information, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally

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related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. The sub-parts of coats et al are capable of being printed with mailing requirement information depending on what the end user wishes to place on the sub-parts

***Allowable Subject Matter***

5. Claims 9-16 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a mailing assembly comprising: a backing sheet which forms an envelope with a compartment that is adhered to a mailpiece; a mailing form that is removably attached to the backing sheet and is subdivided into a plurality of sub parts, wherein each sub-part is variably printed with information; and further wherein at least one sub-part is inserted into the compartment; and including all of the other limitations of the independent claim.

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***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Petkovsek ('129) discloses a mailing assembly comprising a mailing form and backing sheet.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-16 and 21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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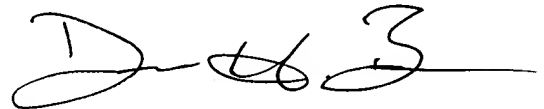
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 22, 2002



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